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OFFICIALPATENT APPLICATION
Do. No. 1941-70

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Paul J. BRUINSMA; Suresh BASKARAN; and
Jagannadha R. BONTA and Jun LIU

Serial No. 09/481,988

Examiner: P. Marcantoni

Filed: January 11, 2000

Group Art Unit: 1755

Original Patent No. 5,922,299

Original Patent Issue Date: July 13, 1999

Confirmation No. 6422

For: MESOPOROUS-SILICA FILMS, FIBERS, AND POWDERS BY EVAPORATION

REPLY BRIEFMail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer in the above-captioned appeal, appellants submit this reply on two issues set out by the Examiner. First, Appellants are not attempting to recapture claims upon which they failed to file a divisional application. Second, the Examiner's improper application of *In re Thorpe*, 227 USPQ 964, does not show why restriction would have been possible between the appellants' process and thin film product-by-process. Under application of the proper standard for restrictions, no restriction would have been proper between the allowed process claims and the product-by-process claims 188 and 189.

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Appellants are not attempting to recapture claims upon which they failed to file a divisional application.

In the Examiner's Answer, on page 4, it was stated that "Appellants are attempting to rectify their error, albeit improperly, by re-issue to *the product claims* for which they failed to file a divisional application [emphasis added]." The claims for which the Appellants now seek issue are not the same as, nor "substantially the same as," the claims that were the subject matter of the restriction requirement that would have resulted in a divisional application. *Ex parte Zambrano*, 58 USPQ2d 1309, 1312.

As discussed in Appellants' brief, the claims subject to the restriction requirement were originally filed claims 25-27 and 28. The claims 188 and 189 at issue here are not the same claims. Appellants submit that claims 188 and 189 are not substantially the same as the claims subject to the original restriction requirement.

The content of the originally filed claims 25-27 and 28, as well as the claims 188 and 189 are provided in Appellants' Brief and are not reproduced here for brevity's sake. Claims 25-27 and 28 were very broadly written product claims directed to powders, fibers and thin films without any process limitations whatsoever. Claims 188 and 189 are very narrowly drawn claims that result directly from the process steps of Appellants' specification. The recapture rule bars a reissue claim if it is as broad or broader than canceled or amended claims in all respects. If the reissue claim is narrower in all respects, the recapture rule does not apply. *In re Clement*, 45 USPQ2d 1161.

It appears that the Examiner has taken the position that, having restricted one set of product claims from the original application, all product claims are now impermissible recapture. Appellants have not been able to locate any ruling from the Board or the Court of Appeals for the Federal Circuit to support this position. There are unpublished opinions on this subject, however.

In an unpublished opinion of the CAFC, *In re Swartzel*, 36 USPQ2d 1510, product-by-process claims are discussed. Swartzel's patent had claims directed to a method and his reissue application sought to add product and product-by-process claims. The examiner refused to enter an amendment adding the product and product-by-process claims. The CAFC noted that "Swartzel cannot be said to have intentionally forfeited claims covering the product."

In *Swartzel*, there was an issue as to whether the Appellant understood the nature of the restriction requirement. In an unpublished opinion of the Board of Patent Appeals and Interferences, however, there was no such issue. In this case, Zambrano tried to add new claims directed to an apparatus in which a previous restriction had been directed to different apparatus claims. The Board found that the claims were not 'substantially the same as' those that had been restricted out of the parent application, and the case was remanded back to the Examiner for a more complete analysis. Appellants submit that the claims 188 and 189 are not substantially the same as the claims that were not elected in the parent case. The Examiner has only addressed the preamble of the claims and has not applied any analysis to the body of the claims. Claims 188 and 189 are not 'substantially identical' and therefore are properly included in this application.

The Examiner's application of *In re Thorpe* to show why restriction would have been possible between the appellants' process and thin film product was improper.

In re Thorpe, 227 USPQ 964, is directed to determining if a product-by-process is unpatentable over the *product* (emphasis added) of prior art, see the MPEP § 2173.05(o). The standard for determination of whether or not a restriction between a process and a product-by-process is proper should be under *In re Bridgeford*, 149 USPQ 55 (CCPA 1966). A process of making and a product made by the process can be shown to be distinct invention if either or both of the following can be shown: (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products,

or (2) that the product as claimed can be made by another and materially different process. See the MPEP § 806.05(f). Therefore, the Examiner's application of *In re Thorpe* is improper.

Further, if the Examiner had applied the proper standard, these claims would have been found to be properly included in this application. The Examiner has made some general assertions but has not shown that any other product could be manufactured by the process claimed in Claims 188 and 189. For example, the Examiner has not addressed the d-spacing of claim 28, supposedly being recaptured by claims 188 and 189, nor addressed how these claims are the same with regard to this aspect. The inclusion of these claims is proper.

Having responded to the Examiner's arguments, Appellants renew their request that the final rejections be reversed.

Respectfully submitted,

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I hereby certify that this Reply Brief is being transmitted to the U.S. Patent and Trademark Office via facsimile number (703) 872-9306, on June 2, 2004.

Signature

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